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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/874,140	06/06/2001	Markus Eickmann	058315/0127	6537
26633	7590	03/14/2006		
HELLER EHRMAN WHITE & MCAULIFFE LLP 1717 RHODE ISLAND AVE, NW WASHINGTON, DC 20036-3001			EXAMINER SALIMI, ALI REZA	
			ART UNIT	PAPER NUMBER
			1648	

DATE MAILED: 03/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/874,140

Applicant(s)

EICKMANN ET AL.

Examiner

A R. Salimi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 15, 16 and 23-25 is/are pending in the application.
- 4a) Of the above claim(s) 25 is/are withdrawn from consideration:
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15, 16, 23 and 24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☒ Certified copies of the priority documents have been received in Application No. 09/219,337.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>6/6/06</u> | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

This is a response to the amendment filed 03/03/2006. Claims 13, 14, 17-22 have been canceled. Claims 23-25 have been added. Claims 15, 16, 23-25 are pending.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Please note any ground of rejection that has not been repeated is removed.

### ***Election/Restrictions***

Newly submitted claim 25 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: VZV VP25 protein is different than the originally claimed protein.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 25 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Claim Rejections - 35 USC § 112***

Claims 15, 16, 23-24 are rejected under 35 U.S.C. 112, second paragraph, for reasons of record advanced in the previous Office Action mailed 10/4/05. Applicants have not addressed the previous rejection in its entirety. As it was articulated Claim 15 is vague and indefinite since, a sequence identification number should identify the intended amino acid region of AA 12 to 235. This affects the dependent claims. Thus, the rejection is reiterated and maintained.

**New Grounds of rejection:**

***Claim Rejections - 35 USC § 112***

Claims 15, 16, 23-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 15, 23-24 are vague and indefinite; none of the “portions” have been defined. There are no sequence identification numbers associated with these portions and no reasonable search can be conducted to determine whether the “portions” are previously taught or disclosed. Claims have been interpreted in view of the specification and since the disclosure does not set forth the fragments the claims are vague and indefinite. This affects claim 16.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 15-16, 23-24 rejected under 35 U.S.C. 103(a) as being unpatentable over Davison et al (J. of General Virology, 1986, Vol. 67, pages 1759-1816).

Davison et al taught a product of gene 23 as a 235 amino acids long polypeptide, which is VP26 (see page 1776, and page 1810). This differs since they did not split the protein into multiple fragments or portions.

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Therefore, one of ordinary skill in the art at the time of filing would have been highly motivated by the above cited art to slice the protein into multiple portions to be used in a diagnostic assay as an immunoreactive peptide. The ordinary skill in the art being familiar with the above cited art would have had ample motivation to slice the protein taught by Davison et al into fragments that would be utilized as a detection product, absent unexpected results. The skill level is rather high in this art and forming large fragments is within the purview of one of ordinary skill in the art. There are no unexpected results in the disclosure and to date none has been shared with the office, and it can be inferred that none existed. Therefore, it would have been obvious to one of ordinary skill in the art to take the protein taught by the above cited art and slice it into portions to be used as immunoreactive peptide. Thus, the invention as a whole is prima facie obvious absent unexpected results.

No claims are allowed.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to A. R. Salimi whose telephone number is (571) 272-0909. The examiner can normally be reached on Monday-Friday from 9:00 Am to 6:00 Pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel, can be reached on (571) 272-0902. The Official fax number is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A. R. Salimi

3/13/2006

AL R. SALIMI  
PRIMARY EXAMINER